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CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1951.

No. 254

AMERICAN STEEL FOUNDRIES,
Petitioner,

vs.

HOLLAND COMPANY,
Respondent.

REPLY BRIEF OF PETITIONER IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

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The Scheffer Press, Inc.—ANdover 3-6850

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Brief for Respondent, page 3, states that the Petition does not involve any important or novel question of law. The question as to whether or not a patent owner may recapture what the patentee expressly abandoned in the Patent Office is an important one. It is an important question as to whether or not the Court of Appeals by its fiat of silence in this case, may reach a result on this question which is in direct conflict with the decisions of this Court. The decision of the Court of Appeals in effect allows a patent owner to abandon a portion of his invention in the Patent Office, thus dedicate it to the public, and, on suing for infringement, recapture it from the public commons. This disregard of the public title and the new bestowal of it presents a matter of novelty.

The fact that the Examiner suggested claim 10 to Goodwin for the purpose of an interference between the Goodwin application and that of one Shafer does not furnish a basis for the Court of Appeals decision which did not refer to or consider the file history, thereby allowing the patent owner to recapture what had been dedicated to the public by the patentee. Claim 10 was taken from the Shafer application which in its entirety was limited to Class One devices. It was awarded to Goodwin who previously, when the Examiner ruled that certain claims of his application covered subject matter wherein the operation did not depend upon the bolster load and therefore related to a "distinct invention" (R. 144), acquiesced therein by cancelling those claims with the comment that the position of the Patent Office was "absolutely correct" (R. 147). The decision of the Court of Appeals gave no heed to and made no mention of the origin of that claim or of the District Court's well grounded finding with respect to it. In this regard this decision is in direct conflict with the decision of the Court of Appeals for the Second Circuit in *Dwight & Lloyd Sintering Co. Inc.* v. *Greenawalt,* 27 F. (2d) 823 (C. C. A. 2, 1928). The Court of Appeals there held that where a parent specification was more limited than the specification of the patent in suit, the claims awarded to the latter must be construed in the light of the more limited parent specification. On page 832 the Court of Appeals for the Second Circuit stated:

> "* * * Greenwalt's monopoly may be limited, and the public demesne enlarged, by an interpretation which contracts his claims to less than they might cover, if the specifications stood bare. And so we think they must be."

The proposition that a claim originating in an interfering application, the specification of which is more limited than that of the application to which the claim is awarded, shall not receive an interpretation based upon the broader specification, especially where the latter was narrowed by the applicant in order to secure the grant of a patent, is an important and novel question of law. Its importance and novelty are especially emphasized by the difference of views on this question in the Seventh and Second Circuit Courts of Appeal.

As far as Petitioner's research has disclosed, this question has never been presented to this Court.

Also, it is a novel proposition that an applicant can regain in a subsequent interference proceeding what he had expressly abandoned and dedicated to the public, and this through a claim which was taken from an application that would not support any claim upon the abandoned subject matter.

The brief for Respondent does not deny that the patentee of the Goodwin patent made an election in the Patent Office eliminating Class Two devices from the patent, nor does it deny that the accused car trucks are Class Two devices.

The reference (Respondent's Brief, p. 4) to Claim 2 suggests that Class Two devices were claimed in the patent is wholly erroneous. Claim 2 relates to a Class One device of the type illustrated by Figure 8 which the Patent Office found related to a "distinct invention, since the operation does not depend on the bolster load" (R. 144) and as Goodwin conceded "the position of the Office being absolutely correct" (R. 147). Respondent ignores the preceding portion of Claim 2, "wedging means carried in part by said shoes, *for forcing said shoes apart*

as the load on the bolster increases". From this alone it is apparent that Claim 2 relates to a Class One device wherein the friction depends upon the bolster load. The addition of spring pressed plates in Claim 2 does not change its classification to the constant friction devices of Class Two, expressly found by the Patent Office to constitute a distinct invention, which Goodwin abandoned, conceding the Patent Office determination to be correct. That the addition of a constant force to a variable force can but result in a variable force is an elementary law of mechanics (R. 103). Respondent produced no evidence to dispute this fact.

The statement (Respondent's Brief, p. 4) that the Court of Appeals found nothing in the file wrapper to impose limitations on Claim 10 is only a partial truth. The Court of Appeals in its opinion (R. 269-272) did not mention the file wrapper and although the District Court's opinion (Findings of Fact and Conclusions of Law, R. 177-181) shows that the District Court found non-infringement because of the limitation necessitated by the file wrapper, the Court of Appeals reversed without the slightest reference to this point. The Court of Appeals for the Seventh Circuit gave no consideration either to the basis of the District Court's opinion or to the file wrapper.

Respondent does not dispute that the decision of the Court of Appeals for the Seventh Circuit in reversing the District Court and in stating that the District Court "was clearly in error" without referring to or considering the thoroughly grounded fact findings of the District Court or the basis of that Court's decision is such a departure from the accepted and usual course of judicial proceedings and from Rule 52 of the Federal Rules of Civil Procedure as to call for the exercise of this Court's

power of supervision. This is the second ground upon which the discretionary power of this Court is invoked.

It is respectfully submitted that this Court exercise its discretionary power and issue the writ of certiorari as prayed for in the Petition.

Respectfully submitted,

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September 22, 1951.

Service of the above, together with a copy of same, acknowledged this ..... day of September, 1951.

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For the Respondent.